

**REMARKS**

This paper is submitted in response to the Final Office Action mailed February 2, 2005.

Claims 1-7, 9-12, 16-18, and 21-31 are pending. Claims 1, 7, 9, 16, 24, 26, and 29 have been amended. Support for the amendments to the claims may be found throughout the specification and claims as discussed below. Since support for the amendments can be found in the specification, there is no new matter added as a consequence of the amendments to the claims.

**The Rejections under 35 U.S.C. § 103(a) Should Be Withdrawn**

The Examiner has maintained the rejection of claims 1-3, 6, 7, 9-12, 16, 17, and 21-31 under U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,311,700 to Thomas in view of Netherlands Patent NL 8700470 to Dekker. The Examiner alleges that Thomas teaches a method of manufacturing a plant support manufactured having an at least partially covered open wall, the box-shaped element being at least partially covered with a preferably substantially biodegradable covering material, the covering material being provided in such a manner that it covers the partially open wall at least partially, such that the wall becomes soil proof, while roots of a plant, growing in a pot during use, can grow at least partially through the covering material and the wall to the outside of the plant support, characterized in that as covering material a material that is manufactured from biodegradable material. The Examiner acknowledges that Thomas is silent on the substantially vertical extending guide element mounted on the box-shaped element. However, the Examiner alleges that Dekker teaches a substantially vertical extending guide element mounted in combination on a box-shaped element. The Examiner also alleges that it would have been obvious to the skilled artisan to modify the

teachings at the time of the invention since it is old and notoriously well known in the art of plant husbandry to provide a vertical support for plant to control the shape of the plant and to prevent the plant from bending and resulting in damage to the plant stem.

The Examiner has maintained the rejection of claims 4, 5 and 18 under U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,311,700 to Thomas in view of Netherlands Patent NL 8700470 to Dekker as applied to claim 1, and further in view of U.S. Patent No. 3,958,365 to Proctor. The Examiner alleges that Thomas as modified teaches a polyurethane liner, but acknowledges that it is silent on the covering material being made from at least natural fibers and binding agent. The Examiner alleges that Proctor teaches a wire basket liner made of coco fiber and latex and is a polymer liner. The Examiner further alleges that it would have been obvious to the skilled artisan to modify the liner of Thomas with the natural fibers of Proctor for the efficient means of conserving moisture in the soil which plants grow, since the modification is allegedly an alternate plastic/polymer liner that contains soil and permits growth of roots through the liner.

The Examiner states that the arguments submitted in the Response to Office Action mailed Nov. 10, 2004 have been considered, but are allegedly moot in view of new grounds of rejection. The Examiner alleges that it would be obvious to one of skill in the art at the time of the invention to look to Dekker to modify the teachings of Thomas, since Thomas teaches shrubs and plants, in addition to trees. The Examiner also alleges that Thomas teaches the biodegradable limitations of the presently pending claims. The Examiner further alleges that Thomas as modified by Dekker inherently teaches that the guide element can be demountable and that one or more plants are on both sides of the vertically extending guide. The Examiner

also alleges that Cahill teach that the plant remains in the wire container and that the wire container and plant are both inserted in the ground.

Applicant respectfully disagrees with the Examiner's contentions. To establish a *prima facie* case of obviousness, three basic criteria must be met (MPEP 2142). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1981).

Applicant maintains that there is no suggestion or motivation provided in Thomas to modify the disclosed container for plants. Applicant also maintains that Thomas fails to disclose the substantially vertical extending guide element mounted on the box-shaped element and the box shaped element being at least partially covered with *substantially biodegradable* covering material. Therefore, applicant continues to assert that the Thomas fails to teach or suggest all claim limitations of the present invention.

Applicant also submits that there is no suggestion or motivation provided in Thomas to combine its teachings with any other references, either Dekker or Proctor. Without a teaching or suggestion of a need to modify Thomas, there is no suggestion or motivation to look for another reference to combine the cited references in either reference so as to arrive at the claimed invention.

Without conceding the correctness of the Examiner's rejections, Applicants have amended claims 1, 9, 16, 24, 26, and 29 to recite a guide element positioned midway between two walls of the box element. Support for the claim amendments can be found throughout the specification and claims as filed and, in particular, at page 8, lines 16-17, page 13, lines 17-20, Figures 2A, 2B, 2C, 7, and 8. Applicant submits that neither Thomas, Dekker nor Proctor disclose such a vertical guide element found within one box element positioned midway between the walls of the box element. This distinctive feature allows the use of only one box element to produce a hedge that can covers both sides of the guide element and can be used as a separation of two adjacent gardens. Dekker only discloses a vertical wall that is an extension of the wall of the box element, requiring that two box elements be positioned back to back to provide for a separating hedge. Therefore, applicant submits that the pending claims, as amended, are patentable over the cited art and request the withdrawal of the rejection of the claims.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully requests withdrawal of the outstanding rejections and allowance of the pending claims.

Applicant does not believe that any fee is required in connection with the submission of this document. However, should any fee be required, or if any overpayment has been made, the Commissioner is hereby authorized to charge any fees, or credit or any overpayments made, to Deposit Account 02-4377. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BAKER BOTTS L.L.P.

By:   
Gary M. Butter  
Patent Office Reg. No. 33,841

Dana Lau  
Patent Office Reg. No. 55,361

30 Rockefeller Plaza  
New York, NY 10012-4498  
(212)-408-2500